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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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## Office Action Summary

Application No.

10/643,983

Applicant(s)

BURWELL ET AL.

Examiner

ALEXANDER BOAKYE

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17 is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/18/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

### ***Double Patenting***

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1, 3 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 3 of prior U.S. Patent No. 6,650,646 This is a double patenting rejection.

Claim 2 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 2 of prior U.S. Patent No. 6,650,646 This is a double patenting rejection.

Claim 4 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 4 of prior U.S. Patent No. 6,650,646 This is a double patenting rejection.

Claim 5 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 5 of prior U.S. Patent No. 6,650,646 This is a double patenting rejection.

Claim 14 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 6 of prior U.S. Patent No. 6,650,646 This is a double patenting rejection.

Claim 15 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 7 of prior U.S. Patent No. 6,650,646 This is a double patenting rejection.

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2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 6 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No.5,818,842. Although the conflicting claims are not identical, they are not patentably distinct from each other because both Applications recite means for transmitting data including errors from a port to be monitored over the network to a remote monitoring site to replicate the data from the monitored port at the remote monitoring site, whereby tests can be conducted on the monitored port remotely as on-site with the only difference between the patent application and claim 6 of the current application being that claim 5 of the patent application discloses a computer communications system while claim 6 recites digital communication system comprising a transport fabric access devices. Therefore, it

would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of the instant application using the claims of the patent application for the benefit of transporting packet at high speed.

Claim 8 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No.5,818,842. Although the conflicting claims are not identical, they are not patentably distinct from each other because both Applications recite means for tagging monitored data packets to prevent them from being treated as normally received packets by the receiving interface means with the only difference between claim 8 of the current application and claim 6 of the patent being that claim 6 of the patent application discloses a computer communications system while claim 8 recites digital communication system. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of the instant application using the claims of the patent application for the benefit of transporting packet at high speed.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 6-11,13 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Hiller et al. (US Patent # 5,452,297).

Regarding claim 6, Hiller teaches a digital communication system (Fig. 22 and ) comprising a transport fabric access devices (ATMU of Fig.22) having ports for permitting access to the transport fabric (ATM-CM of Fig. 22),and means for transmitting data including errors from a port to be monitored over the network to a remote monitoring site to replicate the data from the monitored port at the remote monitoring site, whereby tests can be conducted on the monitored port remotely as if on site (column 25, lines 34-37 and column 43, lines 3-6; the claimed replicate the date is inherent in the administration module of Hiller).

Regarding claim 7, Hiller further teaches a centralized routes (Terminal Server of Fig. 22) for distributing topology information to the access devices (ATMU of Fig. 22).

Regarding claim 8, Hiller teaches means for tagging monitored data packets to prevent them from being treated as normally received packets by the receiving interface means (column 43, lines 3-20).

Regarding claim 9, Hiller teaches a digital communications system (Figs. 22-23) comprising a connection-oriented transport fabric (column 25, lines 17-19) comprising at least one packet switch (column 26, lines 5-7; 519 of Fig. 23), a centralized OAM (Operations and Maintenance) resource

(Broadband OA&M of Fig. 22) and means for extracting OAM packets from a packet stream and redirecting the packets through the transport fabric to the centralized OAM resource for processing (column 25, lines 17-33; the claimed means for extracting OAM packets is inherent in the Administration module of Fig. 22).

Regarding claim 10, Hiller further teaches that the connection-oriented transport fabric is an ATM network and the packets are ATM cells (column 25, lines 17-28).

Regarding claim 11, Hiller teaches a digital communications system (Figs. 22-23), an interface between a connectionless and connection-oriented network (column 26, lines 5-26), comprising means for snooping (monitoring) the incoming first packet from the connection-oriented network and deriving the destination address therefrom (column 25, lines 34-37 and column 43, lines 3-6), and means for appending the thus-derived address to outgoing frames on the connectionless network (lines 21-29 of the abstract).

Regarding claim 13, Hiller teaches an interface for establishing communication between a connection-oriented transport fabric and a connectionless fabric in a digital communications system (Figs. 22-23 and 46) having a centralized route server (Terminal server of Fig. 22), the interface device (ATM-CM of Fig. 22) comprising first port means (ATM port of Fig. 22) for connection to the connection-oriented fabric (ATM-

CM of Fig. 22) second port means (ATM of Fig. 22) for connection to the connectionless fabric, translation means (4028) for translating data between formats adapted for the connection-oriented and connectionless networks, a memory (430) for receiving and storing information from the centralized route server pertaining to the location of devices attached to the system, and a transfer engine for forwarding received data toward its destination using the stored information (column 54, line 48-column 55, lines 1-10).

Regarding claim 16, Hiller teaches a method of controlling a digital communications systems (Figs. 22-23) with a connection-oriented transport fabric (column 25, lines 17-19) comprising the steps of extracting OAM (Operation and Maintenance) packets from a packet stream in a processing engine (column 25, lines 17-33; the claimed means for extracting OAM packet is inherent in the administration module of Fig. 22), and redirecting the OAM packets through the transport fabric to a centralized OAM resource for processing (column 25, lines 17-33).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hiller et al. (US Patent # 5,452,297) in view of Murakimi (US Patent # 5,621,726).



Regarding claim 12, Hiller teaches all the claimed limitations as previously discussed with respect to claim 11 above, but fails to explicitly teach where the destination address is the MAC address. However, Murakimi reference Fig. 4a discloses that the destination address is the MAC address (column 5, lines 28-40). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Hiller to include the feature that destination address is the MAC address such as the one taught by Murakimi with motivation being that it provides network security.

#### ***Allowable Subject Matter***

5. Claim 17 is allowable.

The following is a statement of reasons for the indication of allowable subject matter: As to claim 17, the prior art of record does not teach (a) periodically distributing routing information for devices connected to the transport fabric to access devices connected thereto from a centralized route server over the transport fabric.

#### **Conclusion**

6. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Hiller (US Patent # 5, 345,446) discloses establishing Telecommunications call paths in Broadband communication networks.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Boakye whose telephone number is (571) 272-3183. The examiner can normally be reached on M-F from 8:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham, can be reached on (571) 272-3179. The Fax number is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or PUBLIC PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Electronic Business Center (EBC)** numbers at 866-217-9197 and 703-305-3028.

Alexander Boakye



04/24/07